

REMARKS/ARGUMENTS

The specification has been amended to make editorial changes to place the application in condition for allowance at the time of the next Official Action.

A proposed drawing correction is submitted for Figures 1 and 6 that address inconsistencies between the figures and the specification.

Claims 1-11 are pending in the application. Claim 3 is amended to address the claim objection noted in the Official Action.

Claims 1 and 4 are rejected as unpatentable over OHTANI et al. 6,490,014 in view of JUN et al. 5,844,641. This rejection is respectfully traversed.

MPEP §2143.03 states that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 1 of the present application recites an alignment film being formed on said pixel electrode and in contact with said liquid crystal.

By way of example, Figure 2 of the present application shows alignment film 107 formed on pixel electrode 17 and in contact with liquid crystal 300.

Column 1, lines 26 and 27 of OTHANI et al. disclose that a liquid crystal is interposed between each pixel electrode and an opposed electrode to form a kind of capacitor. Each of the figures of OHTANI et al. only show the substrate (11) that has thin film transistor 12. The opposing substrate is not shown. Accordingly, at best OHTANI et al. teaches liquid crystal between a pixel electrode and an opposed electrode. There is no disclosure of an alignment film formed on the pixel electrode and in contact with the liquid crystal as recited in claim 1 of the present application.

Column 1, lines 21-27 of JUN et al. teach that an active matrix LCD includes a first transparent substrate formed with thin film transistors and pixel electrodes and a second transparent substrate formed with color filters and a counter electrode. A liquid crystal is filled in a space defined between the first transparent substrate and the second transparent substrate. JUN et al. do not teach or suggest that an alignment film is formed on a pixel electrode in contact with the liquid crystal as recited in claim 1.

The above noted feature is missing from each of the references, is absent from the combination, and thus is not obvious to one having ordinary skill in the art.

In addition, as seen in Figure 5 of SAKAMOTO et al. US 2002/0089615, cited in the Official Action and which is offered

to show the state of the art, an alignment film is not formed on pixel electrode 14 in contact with liquid crystal 3.

Since this claimed limitation is not taught or suggested by the cited references, *prima facie* obviousness has not been established. Therefore reconsideration and withdrawal of the rejection are respectfully requested.

Claims 2 and 3 are rejected as unpatentable over OHTANI et al. and JUN et al. as applied to claims 1 and 4 and further in view of SAKAMOTO et al. This rejection is respectfully traversed.

MPEP §706.02(1)(1) states that effective November 29, 1999, subject matter that was prior art under 35 USC 103 via 35 USC 102(e) is disqualified as prior art against the claimed invention if the subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

MPEP §706.02(1)(2) states that "commonly owned" means fully owned by the same person or organization at the time the claimed invention was made.

Applicants hereby assert that at the time the invention was made, the subject matter of SAKAMOTO et al. and the present invention were commonly owned by NEC Corporation.

In addition, SAKAMOTO et al. was filed on January 11, 2002 and published on July 11, 2002. The present application was

filed on February 25, 2002. Since the present application was filed before SAKAMOTO et al. was published, then SAKAMOTO et al. will be available as prior art only under 35 USC 102(e). Therefore, applicants believe that 35 USC 103(c) applies to each claim in which SAKAMOTO et al. is used as a reference.

Accordingly, since SAKAMOTO et al. was applied against claims 2, 3, claims 2, 3 are believed patentable over the cited prior art. Reconsideration and allowance are respectfully requested.

In addition, a verified translation of the Japanese priority application is filed herewith, thereby perfecting applicants' priority claim to the application having a filing date of February 23, 2001.

SAKAMOTO et al. has a U.S. filing date of January 11, 2002. This date is subsequent to the February 23, 2001 priority date of the present application. Accordingly, SAKAMOTO et al. is no longer available as a prior art reference. Therefore, reconsideration and allowance of claims 2 and 3 are respectfully requested.

Claim 5 is rejected as unpatentable over OHTANI et al. and JUN et al. as applied to claims 1 and 4 and further in view of KAWAKAMI et al. This rejection is respectfully traversed.

As noted above, a verified translation of the Japanese priority application is filed herewith to perfect applicants'

priority claim to the application having a filing date of February 23, 2001.

KAWAKAMI et al. has a U.S. filing date of May 22, 2001, which is subsequent to the February 23, 2001 priority date of the present application. Accordingly, KAWAKAMI et al. is no longer available as a prior art reference. Therefore, reconsideration and allowance of claim 5 are respectfully requested.

Claim 6 is rejected as unpatentable over OHTANI et al. and JUN et al. as applied to claims 1-5 and further in view of MURADE et al. 6,249,327. This rejection is respectfully traversed.

MURADE et al. is only cited for the teaching of a scanning line overlapping a contact hole and within a disclination region. MURADE et al. do not teach or suggest what is recited in claim 1. As set forth above, OHTANI et al. in view of JUN et al. do not teach or suggest what is recited in claim 1. Since claim 6 depends from claim 1 and further defines the invention, the combination of references would not render obvious claim 6.

In addition, MURADE et al. do not teach that for which it is offered. Specifically, claim 6 recites that the scanning line has a projecting portion overlapping the contact hole and/or the region where disclination occurs and shielding light.

By way of example, Figure 1 of the present application shows scanning line 12. Scanning line 12 has a projecting portion 12b that has shield portion 12ba and capacitance portion 12bb. This projecting portion 12b overlaps contact hole 18 and overlaps the region where disclination occurs (19) and shields light.

Column 8, line 62 through column 9, line 29 of MURADE et al. in conjunction with Figure 2, teach that a contact hole 8 is between scanning line 3a and capacitor line 3b. A part of lift-up film 13a is formed so as to surround contact hole 8, but the lift-up film 13a is not overlapped with the scanning line 3a and capacitor line 3b. When there is little margin between the contact hole 8 and the scanning line 3a or capacitor line 3b, at least one of the scanning line 3a or capacitor line 3b may be made to form a two-dimensional depression (pressed in a plane) along the regions where the conductive film is provided as shown in Figure 2 so that the scanning line 3a and capacitor line 3b are not overlapped with the lift-up film 13a. Accordingly, the scanning line 3a does not have a projecting portion, but may have a depressed portion to accommodate lifting film 13a. Therefore MURADE et al. do not teach or suggest that the scanning line has a projecting portion overlapping the contact hole and/or the region where disclination occurs and shielding light as recited in claim 6 of the present application.

Claim 7 is rejected as unpatentable over OHTANI et al. and JUN et al. and further in view of MOON. This rejection is respectfully traversed.

The verified translation of the Japanese priority application filed herewith establishes a priority date of February 23, 2001.

MOON has a U.S. filing date of December 13, 2001, which is subsequent to the February 23, 2001 priority date of the present application. Accordingly, MOON is no longer available as a prior art reference. Therefore, reconsideration and allowance of claim 7 are respectfully requested.

Claim 8 is rejected as unpatentable over OHTANI et al. and JUN et al. and further in view of TANI. This rejection is respectfully traversed.

Applicants assert that at the time the invention was made, the subject matter of TANI and the the present invention were commonly owned by NEC Corporation.

In addition, since TANI was filed on September 28, 2000 and issued as a patent on May 21, 2002, and since the present application was filed on February 25, 2002, the present application was filed before TANI issued. Therefore, TANI will be available as prior art only under 35 USC 102(e). Accordingly, applicants believe that 35 USC 103(c) applies to each claim in which TANI is used as a reference.

Since TANI was applied against claim 8, claim 8 is believed patentable over the cited prior art. Reconsideration and allowance of claim 8 are respectfully requested.

Claim 9 is rejected as unpatentable over OHTANI et al. in view of JUN et al. This rejection is respectfully traversed.

Claim 9 recites forming an alignment film on the pixel electrode. The comments above regarding claim 1 are equally applicable to claim 9.

Claims 10 and 11 are rejected as unpatentable over OHTANI et al. and JUN et al. and further in view of SAKAMOTO et al. This rejection is respectfully traversed.

As set forth above, SAKAMOTO et al. is an invalid prior art reference based on the priority date and the common ownership. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

MPEP 706.07(a) states that under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Since applicants have not amended the claims, a second action on the merits denoted as "final" would appear to be

improper if a new ground of rejection is introduced. Accordingly, applicants respectfully request that any subsequent action on the merits be made non-final.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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